

IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1921,

No. 520.

ON PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT
COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

WEBSTER ELECTRIC COMPANY,
Petitioner,

vs.

SPLITDORF ELECTRICAL COMPANY.

BRIEF FOR RESPONDENT.

Respondent would not consider any reply to the petition necessary but for the fact that it wholly fails to set forth the facts of the case upon which the decision sought to be reviewed was based. The record is a voluminous one of nearly a thousand printed pages, besides a printed Interference Record which accompanies the main record as an exhibit. The petition

and accompanying brief contain no references to the record, and will lend the Court no assistance in examining it to determine what the facts of the case are. We shall, therefore, endeavor to briefly state them, with appropriate references to the record, in this reply, and to show that the case was decided upon familiar principles of the patent law often applied by this Court as well as the inferior courts, and not upon any new and unprecedented defence as asserted in the petition and the accompanying brief.

The defense upon which the two claims of the Kane patent which were in issue were held invalid was, broadly, that of laches, and was predicated upon the fact that the claims in question were not introduced into the application for the Kane patent until more than eight years after the filing of the application, and nearly nine years after the subject-matter of the claims had been introduced into extensive public use by interests adverse to Kane and not claiming to act under any right or license from him, and about the same length of time after the subject-matter of the claims had been disclosed in a patent issued to another party; and when the claims were finally introduced into the application (no similar claims having been previously embodied in it), they were admittedly and avowedly introduced for the purpose of dominating constructions disclosed in patents issued to others, under which the defendant in the present case was licensed and operating. Indeed, startling as the statement may seem, the claims in question were not introduced into the application for the Kane patent *until three years after the present suit was begun*, the original bill having been based upon other patents (the Podlesak patents), and the Kane patent having been

brought into the case by supplemental bill after its issue more than three years after the filing of the original bill.

A more gross and inexcusable case of laches, and a more inequitable attempt to overreach the public in general and the defendant in particular, by the introduction of claims into a pending application for the purpose of dominating and suppressing devices which had been patented to others and gone into extensive public use many years prior to the introduction of such claims, has rarely come before the courts; and the facts presented bring the case squarely within the rulings of this Court in such familiar cases as *Railway Co. v. Sayles*, 97 U. S. 554, 563; *Hobbs vs. Beach*, 180 U. S. 383-396, and a multitude of rulings of the inferior courts following those and other leading cases in this Court. The specific facts of the case also seem to bring it within the ruling of this Court in the recent case of *Chapman vs. Wintroath*, 252 U. S. 126, but its disposition on the defense of laches is in no way dependent upon the application to it of the ruling in that case

THE FACTS OF THE CASE.

The application for the Kane patent was filed in the Patent Office on February 2, 1910. (Rec., Vol. 2, p. 502.) As filed, it contained no description of the subject-matter of Claims 7 and 8, which were introduced into it eight years later, under the circumstances above described, *and no claim in any way directed to or towards such subject-matter*. (See claims at pp. 514-520). Indeed, it may well be questioned (and there was earnest controversy over it in the courts below) whether the Kane application as filed contained any

adequate *disclosure* of the subject-matter of Claims 7 and 8 subsequently introduced into it, such disclosure being entirely dependent upon such information as might be gleaned from the very obscure and inadequate drawings of the application.

The patentee Kane, called as a witness on behalf of plaintiff, admitted on cross-examination that he never intended to disclose or claim the subject-matter of Claims 7 and 8 as any part of his invention at the time he explained his invention to his attorney and gave instructions regarding the preparation of his application. On the contrary, he testified that he did not consider it an invention at all, but a mere matter of design, and so stated to his attorney. (Rec., Vol. I, pp. 277-278, 281.) Thus, at p. 278, referring to the subject-matter of Claims 7 and 8 and to his interview with his attorney at the time he placed the preparation of his application in his hands, Kane testified:

“Q. You did not consider it of very much importance; is that right?

A. It seemed to me a matter more of design than importance—invention.

Q. Is that what you told him?

A. Yes, sir.

Q. And you told him that you thought it was not an invention, and was a mere matter of design? You told that to Mr. Sprinkle, did you, when you went to him to get a patent?

A. I told him it was a good means and preferred means of fastening the magneto on the engine.

Q. Well, I ask you if you told him that you thought it was a mere matter of design, and not an invention.

A. I possibly did, yes.”

And at the bottom of page 281:

“A. I told Mr. Sprinkle that combining this plug and the casting on it I did not think there was any invention in that.”

The subject-matter of Claims 7 and 8, therefore, was not only not disclosed or claimed as any part of Kane's invention in his application as originally filed, but he had no thought or intention of disclosing or claiming it as any part of the invention which he desired and intended to patent. The invention which he thought he had made, and which he instructed his attorney to describe and claim as his invention in the application he was to prepare, related to an entirely different subject—to a so-called automatic cut-out, to which the claims of his application were directed. (Rec., Vol. II, pp. 514-520.)

The claims of the Kane application were repeatedly rejected and amended during the four years following the filing of the application (pp. 522-540), and on April 18, 1914, the two claims remaining in the application were finally rejected on references of record (p. 540).

On October 24, 1914, Kane submitted an amendment to his application by which he sought to introduce into it six claims copied from a patent which had been issued to one Milton on May 12, 1914, stating in the “remarks” accompanying the claims that:

“The above claims taken from patent No. 1,096,048, granted May 12, 1914, to J. L. Milton, 1 to 6 verbatim thereof, are sought to be entered in accordance with the provision of Rule 68.

Applicant has just discovered that this Milton patent has been granted, and the claims are entered for the purpose of securing an interference with said patent.”

(Rec., Vol. II, pp. 541-544.)

No one of these claims, copied from the Milton patent and sought to be introduced in the Kane application, related in any way to the subject-matter of Claims 7 and 8 subsequently introduced in the Kane application. The Milton patent did, however, contain a full and complete *disclosure* of the subject-matter of said Claims 7 and 8, as did also an earlier British patent which Milton had obtained upon the same structure, dated October 28, 1909, and bearing No. 24,838 of that year. (Rec., Vol. II, pp. 397-403.) Plaintiff (petitioner) owned Milton's invention, or controlled it under a contract of purchase with him, and had been operating under it from a date prior to the filing of Milton's British application. It began the manufacture and commercial introduction of the Milton magneto (disclosed in his British and later in his American patent) on an extensive scale in the summer and fall of 1909 and continued the same thereafter without interruption, advertising it as Milton's magneto and representing it as being of his invention or production.

When Kane sought to amend his application by introducing into it six claims copied from Milton's American patent, as above stated, the Patent Office Examiner refused to admit the amendment for a number of reasons (pp. 550-551), and advised the applicant that if he desired to contest an interference with Milton on the claims in question he should embody them in a divisional application. Accordingly, on January 14, 1915, Kane filed a divisional application embodying the six claims copied from Milton's patent, and no others (pp. 622-632). The prosecution of Kane's original application, on the two rejected claims relating to the "automatic cut-out," was continued, and the claims ultimately secured by appeal (pp. 552-

621), and a patent issued to Kane upon the application, bearing No. 1,204,573, and dated November 14, 1916 (p. 917).

As before noted, the claims copied from Milton's patent and embodied in the divisional application filed by Kane on January 14, 1915, did not relate in any way to the subject-matter of Claims 7 and 8 subsequently introduced into such application. Therefore, up to and including the time of the filing of his *divisional* application, which was practically five years after the filing of his *original* application, Kane made no claim whatever, of any kind, broad or narrow, relating to the subject-matter of Claims 7 and 8 which were introduced into his application three *additional* years later.

On March 24, 1915, the Examiner rejected one of the six claims of Kane's divisional application (Vol. 2, p. 633), and in response to this rejection Kane on April 17, 1915, presented an argument in support of the patentable novelty of the claim, and in addition presented nine new claims copied from a then recently reissued patent of one Podlesak, dated February 9, 1915, and bearing No. 13,878 (Vol. II, pp. 634-639). With reference to these claims Kane's attorneys said (p. 639):

"Applicant has noted the Examiner's reference to the Podlesak patents Nos. 1,098,052 and 1,055,076. Applicant also notes that the patent No. 1,055,076 was reissued as reissue No. 13,878 of February 9, 1915. A careful consideration of the claims of the reissue patent would indicate that Claims 13 to 15, inclusive, and Claims 19 to 24, inclusive, read equally as well upon applicant's structure as upon the structure shown in the Podlesak patent. As applicant's original applica-

tion, of which the present application is a division, was filed long prior to the filing date of the original, applicant has incorporated these claims in the present amendment, and asked that they be entered, and that an interference with Podlesak, as well as with Milton, be declared as soon as practicable."

Certain of these claims copied from the Podlesak patent and thus introduced into Kane's divisional application (Claims 10, 11 and 12), related to the subject-matter of Claims 7 and 8 subsequently introduced into Kane's application, being narrow or specific claims directed to such subject-matter. Thus Claim 10 included the salient and distinguishing feature of Claims 7 and 8 as

"An integral bracket upon and in which all of the aforesaid mechanism is mounted,"

Claim 11 referred to it as

"A unitary bracket comprising a body in which the relatively fixed and movable electrodes are mounted and a shelf extending laterally therefrom and integral therewith upon which the said generator is mounted."

Claim 12 refers to the same feature as

"An integral bracket having a body in which the said electrodes are mounted and a shelf laterally extending therefrom and upon which the said generator is mounted."

These three claims constituted Claims 19, 20 and 21 of the Podlesak reissue patent No. 13,878 (Rec., Vol. II, p. 911), and were specific claims to the same sub-

ject-matter that was later more broadly and generically claimed in Claims 7 and 8 subsequently introduced into the Kane application.

The Patent Office Examiner rejected all nine of the claims copied from the Podlesak reissued patent and sought to be introduced into Kane's application by this amendment, upon the ground that there was no foundation for such claims in the disclosure of the Kane application (p. 642). In response to this rejection, Kane's attorneys filed a long argument in support of the assertion that Kane's application did contain a sufficient disclosure of the subject-matter of the claims to warrant their introduction (pp. 649-656), and from the refusal of the Examiner to admit the claims finally took a petition to the Commissioner of Patents (pp. 660-664), to which the Examiner replied (pp. 664-665), which petition was denied by the Commissioner (p. 665). Following such denial, Kane filed an amendment to his application by which he introduced into it new descriptive matter (pp. 656-657), and then took a further petition to the Commissioner (pp. 670-672), which was replied to by the Examiner (p. 672), and denied by the Commissioner (p. 673).

Following these proceedings Kane, on October 18, 1915, filed a further amendment (pp. 675-678) by which he introduced still further new descriptive matter into his specification, being that now appearing at lines 69 to 75 on page 1 of the patent as issued (p. 933), and all the matter now appearing at lines 35 to 104 on page 2 of the specification of his issued patent (p. 934).

Following these amendments, the claims in question were admitted and an interference with the Podlesak reissued patent was declared (pp. 679-682).

The proceedings in this Kane-Podlesak Interference are not printed in the main record (where they would naturally follow page 686), but are contained in a certified copy of the printed record of the interference as presented to the Court of Appeals of the District of Columbia, which is in evidence as defendant's Exhibit No. 56. Reference will be made to it as the Interference Record.

Upon the filing of the preliminary statements of the parties it was found that Kane's filing date was earlier than Podlesak's claimed date of invention, whereupon a rule was issued upon Podlesak (in accordance with usual Patent Office practice) requiring him to show cause why judgment should not be rendered against him. (Intf. Rec., 127.) Podlesak thereupon moved to dissolve the interference (which he had not sought) upon three grounds, as follows:

First, that Kane had no right to make the claims in issue because of laches on his part, the claims not having been presented by him for more than two years after the issue of the original Podlesak patent, and not until sometime after the issue of the reissued patent.

Second, that the claims, properly construed, were not readable upon Kane's disclosure.

Third, that if the claims in issue were to be construed broadly enough to be readable upon both Podlesak's and Kane's disclosure, they were met by the prior art. (Intf. Rec., 127-131.)

This motion was supported by a brief filed on behalf of Podlesak and printed in the Interference Record referred to (pp. 132-137).

The motion was denied by the Examiner of Interferences, upon a report by the Law Examiner (pp. 138-

43) and Podlesak appealed to the Board of Examiners-in-Chief. (p. 144.)

This appeal was taken on April 5, 1916, and on April 20, 1916, plaintiff-petitioner purchased the Kane application and its attorneys were substituted for those previously employed by Kane by a power of attorney from him bearing the last mentioned date. (Rec., Vol. 2, pp. 684-686.)

On Podlesak's appeal above referred to, the Board of Examiners-in-Chief reversed the decision of the Examiner of Interferences, upon the ground that Kane was barred by his laches from making the claims in question, under the decision of the Court of Appeals of the District of Columbia in *Rowntree v. Sloan*, 227 O. G., 744, the opinion of the Examiners-in-Chief being found at pages 161-162 of the Interference Record.

Kane acquiesced in the decision of the Examiners-in-Chief with respect to the first three counts or claims of the interference, but appealed to the Commissioner in respect to the remaining counts. (Intf. Rec., 162, 163.) The Commissioner affirmed the decision of the Examiners-in-Chief, but based his decision upon the ground that the claims in question were not readable on Kane's disclosure (Intf. Rec., 174-176) whereupon Kane appealed from the decision of the Commissioner to the Court of Appeals of the District of Columbia (p. 176).

The Court of Appeals affirmed the decision of the Commissioner and Examiners-in-Chief in favor of Podlesak, in an opinion found at pages 700-702 of Vol. 2 of the main record; basing their decision both upon the ground of Kane's laches in making the claims in question and upon the ground that they were not readable upon his disclosure.

Following the decision of the Court of Appeals, the Patent Office Examiner rejected the nine claims which have been involved in the Podlesak Interference, but allowed to Kane two claims of very much broader scope than any involved in the interference, which were presented by an amendment to Kane's application filed on June 7, 1918, and accompanied by an argument of Kane's new counsel (petitioner's counsel) making reference to an oral interview held by them and by plaintiff's general manager with the Examiner. (Main Rec., Vol. 2 pp. 687-693.)

These new claims, which became claims 7 and 8 of the Kane patent as finally issued, were not open to one of the objections upon which the other nine claims had been finally rejected and cancelled, to wit: that they were not readable upon Kane's disclosure, since they were so broad and general in their terms that they were readily readable upon both that disclosure and Podlesak's, and dominated the latter and the more limited claims directed to it.

They were, however, open to the objection that Kane was not entitled to make the claims because of laches, upon which ground the Board of Examiners-in-Chief had rejected the claims which Kane had copied from the Podlesak patent, and which was one of the grounds upon which the Court of Appeals had affirmed that rejection. In other words, after the Examiners-in-Chief and the Court of Appeals of the District of Columbia had both held that Kane had no right to make the more specific claims on the Podlesak patent, because of laches, the Primary Examiner allowed to him two very much broader claims *directed to the same subject-matter*, these latter claims having been presented for the first time by an amendment filed *five years*

after the issue of the original Podlesak patent disclosing their subject-matter, *and more than eight years after the filing of Kane's application.*

Plaintiff held a license under the Podlesak patent whose claims it sought to take away from Podlesak and appropriate to itself in the Kane-Podlesak Interference (Rec., Vol. 1, pp. 52-57), in which it expressly admitted the validity of the patent, and in which it was further expressly covenanted and agreed that the parties to the license contract:

"will aid and assist each other in the prosecution of said application and the obtaining of patents thereon *and in any interference proceedings relating to their right of priority to said invention* and in any suit or proceedings brought under any of said patents." (p. 53.)

Plaintiff's acquisition of the Kane application and its prosecution of the interference with Podlesak was therefore not only a violation of this covenant, but it was a direct attack upon the validity of the claims of the Podlesak patent, under which plaintiff was licensed, and whose validity it had expressly admitted in the license contract, such prosecution of the interference involving, as it did, an assertion of priority of invention of the subject-matter of such claims by Kane.

After acquiring the Kane application on April 20, 1916, as heretofore noted, plaintiff proceeded to carry on the interference which had been previously declared between the Kane application and the Milton patent (Rec., Vol. 2, pp. 362-500). Inasmuch as plaintiff owned or controlled the Milton patent and had been operating under it from the date of Milton's invention, its acquisition of the Kane application gave it control

of both sides of the Kane-Milton interference, and from that date the prosecution of the interference on behalf of both parties was carried on by plaintiff's attorneys, with the result that priority of invention was awarded to Kane, and the claims which had been copied from Milton's patent and introduced into Kane's application, as heretofore noted, were allowed to Kane and now appear in the Kane patent in suit as Claims 1 to 6.

RÉSUMÉ.

The situation which resulted from the proceedings which have been reviewed, therefore, was as follows:

1. Plaintiff secured, in a second patent, the same identical claims which it had secured four years earlier in its Milton patent, thus prolonging its monopoly under those claims by that length of time.

2. After an unsuccessful effort to secure, for itself, nine claims of the Podlesak patent under which it held a license, and whose validity it had both impliedly and expressly admitted—an effort which it carried, by successive appeals, all of the way to the Court of Appeals of the District of Columbia—it secured in the Kane patent two claims of very much broader scope than the claims which it sought to take from Podlesak, which additional claims were introduced into Kane's application for the first time more than eight years after the filing of the application, nearly nine years after their subject-matter had been disclosed in Milton's British patent, and nine years after plaintiff, operating under Milton's invention and his American application and patent, had introduced the claimed invention into extensive public use. Indeed, three years after defendant's devices, against which the claims are as-

serted in the present suit, had been placed on the market, and nearly that length of time after the present suit was filed.

What plaintiff in effect accomplished was to re-issue its Milton patent, with broad claims to subject-matter not in any way covered by the claims of the original patent—claims which it could not lawfully have made in a reissue application—and at the same time extend the period of the monopoly of the original patent four years.

THE LAW—AUTHORITIES.

The decision of the Court of Appeals of the District of Columbia in the Kane-Podlesak interference denying Kane's right to Podlesak's claims because of laches was based in part upon its rulings in earlier cases such as Rowntree vs. Sloan, App. D. C., Vol. 45, p. 207; 227, O. G., 774, in which it had held that an applicant who failed to present claims for subject-matter disclosed and claimed in a patent issued to another for more than one year after the issue of such patent would be refused allowance of such claims and an interference with the issued patent. The ruling announced in that case was subsequently modified by this court in the case of Chapman vs. Wintroath, 252 U. S. 126, in which this court held that such claims would not be barred unless their subject-matter had been disclosed and claimed in a patent to another issued more than *two* years prior to the filing of the application containing the claims in question. In the instant case Kane's divisional application, in which the claims here in controversy were first presented, was filed on January 14, 1915, and the first claims in any way directed to or towards the subject-matter of

Claims 7 and 8 of the Kane patent as issued were introduced into the Kane application by the amendment filed on April 19, 1915 (Rec., Vol. 2, p. 634). This was more than *two* years after the issue of the Podlesak patent No. 1,055,076, dated March 4, 1913, disclosing the subject-matter of the claims and claiming it in a limited way. If the test of the application of the doctrine of *Chapman v. Wintroath* to the facts of the case is, therefore, the length of time (one year or two years) intervening between the disclosure of the subject-matter in the patent issued to another and the introduction of claims to such subject-matter in a pending application, the present case is not distinguishable from *Chapman v. Wintroath*, and the doctrine announced in that case is applicable to and controlling of it. Whatever may be the view of the court on this point, however, it seems clear that the familiar doctrine of *Railway Co. v. Sayles*, 97 U. S. 554, 563, and the numerous later cases following and applying it, are applicable to and conclusive of the present case, for certainly a more flagrant instance of the broadening out of a pending application and the introduction into it of claims to new subject-matter not previously claimed or indicated to be any part of the invention sought and intended to be patented, for the purpose of dominating and suppressing the use of inventions or devices which the public had been enjoying for years, and in the present instance prolonging in time and extending in scope the monopoly which the owner of the patent had previously held and asserted under another patent, has rarely come before the courts.

After introducing the invention into public use as Milton's invention, and deliberately patenting it as his invention, with full knowledge at the time of all

of the facts now brought forward to show that another was the real inventor, and after advertising and selling the device as "Milton's Magneto," and marking it patented with the date of his patent after the patent issued, and asserting his patent against alleged infringers, plaintiff discovered an opportunity not only to prolong the life of the monopoly which it had been enjoying under his patent, but to widely extend its scope as well, so it acquired Kane's application and succeeded in taking away Milton's claims and repatenting them to Kane by means of an uncontested interference of which it controlled both sides; further attempted, but failed, after carrying its efforts all the way to the Court of Appeals of the District of Columbia, to likewise take away from its licensor, Podlesak, and repatent to Kane, nine claims of Podlesak's patent under which it had been licensed and was operating; and, finally, succeeded in getting through the Patent Office, in defiance and disregard of the decision of the Court of Appeals, two broad claims relating to subject-matter which had not only not been claimed, but which had not been even clearly disclosed in his original application, or in any manner indicated to be a part of the applicant's invention until more than five years after the filing of the application, and a still longer period after their subject-matter had been disclosed in a patent to another and introduced into extensive public use, and which were finally allowed and patented to the plaintiff nine years after their subject-matter had been introduced into public use and placed on sale by plaintiff, operating under the invention and patent of another. Not only so, but the two claims in question were introduced for the first time long after the present suit was filed, and for the manifest

purpose of dominating and controlling the devices and structures of the defendant, at which said suit was directed, which devices were then in extensive public use and on sale.

Surely, there is every equitable and just reason why the ruling of this court in *Chapman v. Wintroath* and the doctrine of *Railway Co. v. Sayles* should be applied with full force and effect to the facts and circumstances of the present case. In *Railway Co. v. Sayles* the court, referring to amendments made to pending applications for the purpose of enlarging their scope, said:

“The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the meantime, any more than it does in the case of reissues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use.”

That such was the exact purpose and effect of the introduction and allowance of Kane's claims now under discussion cannot be doubted. The very devices of the defendant at which the claims are directed in the present suit had been in public use and on sale more than two years prior to the introduction of the claims,—indeed, the suit itself had been pending nearly three years,—so that the purpose and effect of the claims was not only to appropriate that which had, in the meantime, gone into public use at the hands of

the plaintiff, under another invention and patent, but which had likewise gone into public use at the hands of the defendant itself.

In *Hobbs vs. Beach*, 180 U. S., 383, 396, in which the doctrine of *Railway Co. vs. Sayles* was pressed upon the attention of the court in the defendant's behalf, the court declined to apply the doctrine upon the ground that, while there had been an expansion of the original application, such expansion had not been with reference to and had no effect upon anything which had gone into use or been given to the public in the meantime. Referring to the amendments made to the application, and to the machine used by the defendant and known as the Horton machine, the court said (pp. 395, 396) :

"All this was prior to the invention of the Horton machine, which was first put into use in September, 1889. Of course, the amendment of May, 1886, could not have been made with reference to this device. It is true that, in November, 1890, after application had been made for the Horton patent, new specifications and claims were filed, in which the invention was stated much more in detail, and with much fuller and more accurate language than before. But there appears to have been no attempt to expand the original claims for the purpose of including the Horton patent."

After then referring to its prior decision in *Railway Co. v. Sayles*, and quoting the language which we have quoted above, the court continued:

"Had there been any expansion of the original specification and claims subsequent to the introduction of the Horton machine, especially if made with reference thereto, we should not have hesitated to apply the doctrine of that case."

In the case now before the court, on the other hand, Claims 7 and 8 of the Kane patent were introduced into the application three years after defendant's devices, at which the claims are now directed, were put in public use and on sale, and nearly three years after the present suit had been brought—and nine years after the subject-matter of the claims had been introduced into public use and placed on sale by the plaintiff, then operating under Milton's invention and patent. Surely, had the facts of the present case been before the court in the reported case it would not have hesitated to apply the doctrine of *Railway Co. v. Sayles*.

See also:

Steward vs. American Lava Co., 215 U. S., 161.

Kittle vs. Hall, 29 Fed. Rep., 508, 513.

Gunn vs. Savage, 30 Fed. Rep., 366, 368, 369.

Con. El. Light Co. v. McKeesport, 40 Fed. Rep., 21, 26.

Hestonville Co. vs. McDuffee, 185 Fed. Rep., 798, 802.

Gilmer Co. vs. Geisel, 187 Fed. Rep., 606, 610.

United Wireless Co. vs. National Co., 198 Fed. Rep., 386, 395.

Motion Picture Patents Co. vs. Independent Co., 200 Fed. Rep., 411, 414, 416-17.

National Electric Co. vs. Telefunken Co., 209 Fed. Rep., 856, 864-5.

Karl Kiefer Co. vs. Unionwerke, 218 Fed. Rep., 847, 855-6.

CONCLUSION.

As has been stated in the opening part of this brief, while the specific facts of this case bring it within the ruling of Chapman vs. Wintroath, 252 U. S. 126 wrongful acts of Petitioner as herein set forth, render the disposition of this case in no wise dependent upon the ruling in that specific case, but plainly bring it within the well established doctrines governing laches. The decision sought to be reviewed being based on familiar and well established principles of Patent Law was undoubtedly right, and therefore this petition for writ of certiorari should be denied.

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MAR 3 1924

WM. R. STANSBURY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1923.
No. 33.

WEBSTER ELECTRIC COMPANY,
Petitioner,

vs.

SPLITDORF ELECTRICAL COMPANY,
Respondent.

BRIEF
BY
EDWIN J. PRINDLE
AS AMICUS CURIAE.

FILED BY LEAVE OF THE COURT.

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IN THE
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WEBSTER ELECTRIC COMPANY,
Petitioner,

against

SPLITDORF ELECTRICAL COMPANY,
Respondent.

No. 93—October
Term 1923

BRIEF
of
EDWIN J. PRINDLE
AS AMICUS CURIAE.

This brief is written because the decision of the case at bar will involve the determination of a rule of law which is a matter of large public importance.

The writer of the brief has no other interest in the case than the public welfare and has no relation to either party in the suit, nor any interest in any case which could be affected by the decision thereof.

In the case at bar, there will be presented to the Court for determination a rule as to the time within which an applicant for patent may copy claims from a patent granted to another, and may test the question of priority of inventorship of said claims. This brief is

directed solely toward the determination of that rule, in the public interest.

In the case at bar, Kane filed an original application on February 2, 1910, on which Patent No. 1,204,573 was granted on November 14, 1916. Podlesak was granted patent No. 1,055,076 on March 24, 1913. Kane filed a divisional application January 14, 1915, upon which Patent No. 1,208,105 was ultimately granted September 24, 1918. Podlesak applied for a reissue of his patent December 23, 1914, and reissue Patent No. 13,878 was granted February 9, 1915. On April 17, 1915, more than two years after the grant of the Podlesak original patent, but less than two years after the reissue patent, Kane copied three claims from the original Podlesak patent and six from the reissue patent into his divisional and demanded an interference. The Court of Appeals of the District of Columbia finally decided the interference against Kane, basing its decision, both on Kane's laches in copying the said claims and demanding the interference and on the further ground that the claims were not readable upon Kane's disclosure. Kane acquiesced in this decision, and on January 17, 1918, filed an amendment by which he introduced two new claims, 7 and 8, which were broader than, but generic to, the claims which he had copied from the Podlesak patents. These claims were allowed without interference and the patent No. 1,208,105 granted, as above stated.

Kane's divisional application was filed within two years after Podlesak's original patent was granted. Claims 7 and 8 were filed five years after Podlesak's original patent was granted and two years and four months after his reissue patent was granted.

The Amicus Curiae, desiring only to aid in the settlement of the principle involved, does not refer to the showing of the record for or against laches, acquiescence, abandonment, etc.

This Court in *Chapman, et al. v. Wintroath*, 252 U. S., 126, decided that an applicant who has pending in the Patent Office an application disclosing, but not claiming, an invention claimed in a patent granted on an application filed during such pendency is within his rights in filing a divisional application for such invention within two years after the granting of said patent and copying claims therefrom for the purpose of interference.

This Court, however, has not had before it for determination the question of how long after a patent is granted an applicant may copy claims of such patent for the purpose of interference in an application which was pending at the time of the granting of said patent or was filed not more than two years after said granting.

The reasons for limiting the time within which an applicant may copy claims from a patent for purposes of interference are two:

First, the applicant, by obtaining a second patent would extend the time of monopoly of the invention during which the public would have to wait for an opportunity to use it, and unreasonable delay in obtaining the grant of such patent would cause the public to pay tribute or put off the time when it would become public property for an undue length of time; and

Second, to prevent possible injustice to the patentee who may have put the invention on the market or made preparations therefor.

Two rules for the determination of this question successively have been applied by the Patent

Office and the Court of Appeals of the District of Columbia.

The first rule has been that the applicant must copy the claims from the patent within a reasonable time under all the circumstances of a particular case and in the light of the terms of the statute.

The second rule has been to set a fixed time within which all applicants must copy the claims from the patent regardless of any circumstances in the case.

The first recorded cases adopted the first of these rules. They were:

Barber v. Wood, 207 O. G., 299; 1914 C. D. 1.

Shreve v. Grissinger, 202 O. G., 951; 1914 C. D. 491.

In re Fritts, 45 App. D. C., 211; 227 O. G. 742; 1916 C. D. 188.

The Fritts application was filed in 1880, and it was not until 1916 that claims were copied therein from patents which had previously expired, so that a second monopoly of 17 years was sought. The Court of Appeals of the District of Columbia denied the right to claims copied from the patents, saying:

“It was his duty within a reasonable time after the issuance of those patents to assert his claims thereto, to the end that an interference might be declared and the issue of priority determined. By failing to assert such claims, he must be held to have abandoned them.”

The second rule, setting a fixed period after the grant of a patent, after which period no applicant

might copy claims from the patent for purposes of interference, was first adopted in the case of *Rowntree v. Sloan* by the Court of Appeals of the District of Columbia, the decision being reported in 45 App. D. C., 207, 227 O. G., 744; 1916 C. D. 192. The period set was one year.

The decision in *Rowntree v. Sloan* was doubtless influenced by the fact that at that time (1916) the Patent Office was engaged in an active campaign to prevent the practice of wilfully causing applications to remain in the Patent Office for long periods while an art grew up, and to shorten the period of prosecution and reduce the number of such applications. In this case the Court was doubtless influenced by a desire to aid the Patent Office in the said campaign, and accordingly fixed the period within which Sloan should have copied the claims as "at least within the time allowed for amendment after Patent Office action", which is one year.

In 1917, subsequent to the decision in *Rowntree v. Sloan*, Commissioner Ewing decided the case of *Wintroath v. Chapman and Chapman*, 248 O. G. 1003; 1918 C. D. 9. In that case Chapman and Chapman filed an application for patent in 1909, during the pendency of which Wintroath filed an application in 1912, which eventuated in a patent on November 25, 1913, the Chapmans' application having no claims which conflicted with the Wintroath application. About 20 months later, June 6, 1915, the Chapmans filed a divisional application, in which claims of the Wintroath patent were copied and an interference declared between it and the said patent. Wintroath contended that, because of the Chapmans' delay of nearly 20 months in filing their divisional application after

the publication of the Wintroath patent, they had lost their right to contest the priority of the claims, in view of the decision of the Court of Appeals in *Rowntree v. Sloan* (*supra*).

Commissioner Ewing held that the period should be less than two years and, drawing an analogy with the rule in reissue cases, said:

“The rule therefore would set a period of two years as a limit below which delay would not be inquired into and beyond which it must be satisfactorily accounted for.

Under this rule, the Primary Examiner should deny the right of an applicant to make a claim taken from a patent where the period of delay exceeds two years and declare an interference only where a *prima facie* case overcoming the charge of dilatoriness is made out by the applicant.”

Thus, Mr. Ewing, in effect, favored a rule requiring only reasonable promptness under all the circumstances of each particular case, and the time limit of two years which he mentioned was only a time within which the right to make the claims could not be questioned. It seems to the writer that Mr. Ewing would not have mentioned a definite time limit had not the Court of Appeals already fixed a definite time limit in *Rowntree v. Sloan*. He probably felt that he was bound by the holding that there should be a time limit and sought by suggesting two years, to soften the harshness of the one-year rule.

The Court of Appeals of the District of Columbia in

Wintroath v. Chapman & Chapman, 47
App. D. C. 428, 1918 C. D. 154, 248 O. G.
1004,

in deciding the appeal from Commissioner Ewing, refused to accept his suggestion and followed its decision in *Rowntree v. Sloan*, *supra*, saying:—

“We therefore adhere to the rule in the *Rowntree case* but with this modification: The period should be one year unless the applicant shall satisfy the Commissioner that the delay was unavoidable.”

The case was brought to this court on *certiorari* as

Chapman et al. v. Wintroath, 252 U. S. 126.

This court decided that the Chapmans were within their legal rights in filing their divisional application containing claims of the Wintroath patent at any time within two years after the publication of that patent, and that the right to make the application cannot be deemed lost by laches or abandonment merely because of a delay not exceeding the two years allowed by the Statute.

Since the decision of the Supreme Court, the following decisions have been rendered by the Court of Appeals of the District of Columbia in cases in which an applicant has copied a claim of a patent published during the pendency of his application, in which the two years' limit permitted by the Supreme Court for filing divisional cases was applied to the copying of claims from a patent, for purposes of interference:

DeFerranti v. Harmatta, 50 App. D. C. 393, 273 F. R. 357, 1921 C. D. 226, 288 O. G. 205.

In this case a patent was issued to one Rietzel July 20, 1909, from which Harmatta copied claims

which led to an interference resulting in an award to Harmatta, to whom a patent was issued December 3, 1912. DeFerranti first made the claims in issue July 29, 1913, which was more than four years after the Rietzel patent but less than two years after the Harmatta patent. The Court held that DeFerranti was estopped to make the claims against Rietzel, saying:

“The limitation of two years within which claims may be taken from a patent arises from the application of a sound principle of public policy for the prevention of an undue extension of monopoly by procrastination in the assertion of adverse rights against one already in possession. This situation is not different by analogy from a reissue case where the public is in adverse possession. In both instances, the applicant has stood by and permitted others to assert rights which he now negligently seeks to monopolize for himself.”

Ransdell v. Jahns, 51 App. D. C. 3, 273
F. R. 365, 1921 C. D. 228, 288 O. G. 206.

In this case, the Court held that Jahns, being well within the two year period which it had recently fixed by its construction placed upon the rule in *Chapman v. Wintroath* (252 U. S. 126), was not estopped to contest an interference with the patentee.

Replogle v. Kirby, 50 App. D. C. 210, 269
F. R. 862, 284 O. G. 380, 1921 C. D. 138.

The Court held that Replogle, who filed his application more than two months after the granting of the patent to Noguchi, assignor to Kirby, and who copied claims of the patent more than a year thereafter, was not estopped from making

the claims in view of the decision of the Supreme Court in *Chapman v. Wintroath, supra*.

Wells v. Honigman, 50 App. D. C. 99, 267 F. R. 743, 1920 C. D. 242, 280 O. G. 590.

It was here held that a renewal application, although filed 23 months after the filing of the original application, is entitled to the benefit of the filing date of the original application as a constructive reduction to practice, notwithstanding the fact that another had obtained a patent during the period of forfeiture, there being no proof of fact of abandonment of the invention, the Court citing the Supreme Court decision in *Chapman v. Wintroath, supra*.

Wahl v. Main, 51 App. D. C. 398, 280 F. R. 974, 1922 C. D. 133, 303 O. G. 398.

Wahl failed to make the claims of Main's patent until four and a half years after the issue of that patent. No excuse being offered by Wahl for his delay in copying the claims, he was held estopped to make the claims in view of the holding of the Supreme Court in *Chapman v. Wintroath* above cited.

Leonard v. Everett, 52 App. D. C. 90; 281 F. R. 594, 304 O. G. 232; 1922 C. D., 142.

It was held that where an applicant copies apparatus claims of a patent within two years after the grant of the patent, but not more than two years after the invention of the patent has been in public use, he is not estopped, and that where he is entitled to make the apparatus claims he may also make method claims notwithstanding a delay

of more than two years in copying such latter claims after the patent has issued, where the method was an inherent part of the apparatus and anyone using the apparatus must use the method, the Court citing the Supreme Court in *Chapman v. Wintroath*, *supra*.

Browning v. Johnson, 50 App. D. C. 335,
271 F. R. 1017, 1921 C. D. 203, 287 O. G.
785.

In this case, the Court of Appeals of the District of Columbia held that where the patentee derives the invention from the applicant, there was no question of diligence and neither the patentee nor his assignee can charge the applicant with lack of diligence or laches.

Victor Talking Machine Co. v. Brunswick-Balke-Collender et al., 290 F. R.
565.

In this case, which was an action following interference proceedings in the Patent Office which were the subject of the decision in *Browning v. Johnson*, *supra*, the action being to have claim 1 of the Browning patent adjudged invalid and void under R. S. U. S. 4904, 4909, and 4915, the Court comments on the proceedings in *Browning v. Johnson* on pp. 574-575.

As shown by the above case of *DeFerranti v. Harmatta*, there have been three factors influencing the Court of Appeals of the District of Columbia in its selection of a fixed period of two years, after which, if an applicant copies claims from a patent for the purposes of interference, he will be held to have lost the right to such claims

by laches or abandonment in the absence of special circumstances excusing the delay.

These factors are :

First, the protection of the public from an undue extension of the monopoly ;

Second, the preservation of rights of a patentee already in possession from the attack of an applicant who has procrastinated in asserting adverse rights ;

Third, a supposed analogy between delay in copying claims from a patent for purposes of interference and an application to broaden claims by reissuing a patent in which latter case this court has fixed a period of two years unless good excuse for further delay be shown.

Where an applicant intentionally or deliberately delays the issuance of his application for patent by failure to copy the claims of a patent and to demand an interference thereon, the aim is to permit the art to grow up and then to lay it under tribute, and the time when the invention becomes free to the public is in effect delayed beyond the seventeen years contemplated by the statute. Where it is clear that this has been done intentionally, the attempt should be frustrated by the application of the equitable doctrines of limitation, within the terms of the statutes, or the finding of abandonment concerning which there is no statutory limitation.

Since, however, the object of the patent system is to induce inventors to produce inventions, by granting them adequate protection for their inventions, the public good requires that the remedy adopted for frustrating the inventor who overreaches shall not be such as to injure inven-

tors who do not overreach and thus reduce the incentive to inventors in general to invent.

So, also, injustice to the patentee whose claims are copied, due to intentional delay in copying those claims, even though within the statutory periods, and during which the patentee has altered his position to his prejudice, should be prevented.

But the supposed analogy between an applicant who copies claims from a patent for purposes of interference and one who seeks to broaden the claims of his patent by reissuing it needs careful scrutiny.

At the time when the Supreme Court in *Miller v. The Brass Co.*, 104 U. S. 354 (1881) adopted the rule that applications for the reissue of a patent to broaden the claims must be made within two years after the grant of the patent, a very serious situation existed. Patentees frequently waited until other inventors had produced new forms of improvement upon the patented invention and then, with the new light thus acquired, under pretense of inadvertence and mistake, applied for such enlargement of their claims as to make them embrace those new forms. At the time when that decision was rendered, there were roughly 250,000 patents, and of these 10,000 had been reissued, or one patent in every 25. Since that decision, there have been granted roughly 1,200,000 patents, and only 5700 reissues. Thus, only one in every 210 patents have been reissued since the decision in *Miller v. Brass Co.* As that decision did not limit the right of reissue for the purpose of correcting mistakes or narrowing the claims, or making them more specific, and did not interfere with broadening the claims where the application for reissue was filed within two years, the enormous falling off of the proportion of reissues from one in 25

to one in 210 patents following that decision indicates that the abuse which the Court sought to correct was overcome.

But while the abuse of delaying the grant of the original patent by prolonging the prosecution of the application therefor in the Patent Office was of substantial magnitude at the time when the Court of Appeals rendered its decision in *Rowntree v. Sloan*, supra, that abuse has been and is being corrected by means having no harmful reaction upon inventors who are not delaying their applications.

At the time when that decision was rendered, which is the first case in which a uniform period of time was fixed after which every applicant who copies claims from a patent for purposes of interference would be chargeable with laches, the Patent Office under Commissioner Ewing was engaged in a campaign to reduce the number of long-pending applications and to shorten the period of prosecution of applications in general. The Court, in rendering that decision, was doubtless influenced by the desire to assist the Patent Office in its campaign. The means used by the Patent Office was to ask the cooperation of attorneys and inventors, which was frequently willingly given, and to make and strictly enforce a requirement that every amendment of an application for patent should be completely responsive to the last official action under penalty of having the application held to be abandoned, and to keep strict supervision over interferences so as to prevent the declaration of unnecessary interferences and also to prevent dilatory tactics in those which were declared.

The Amicus Curiae has asked the present Commissioner of Patents, Hon. Thomas E. Robertson,

to give a comparison as to length of time of pendency in the Patent Office between the applications before and since that campaign. This he has done in a letter, dated February 5th, 1924, which is printed as a supplement to this brief at p. 26. From this it will be seen that:

NUMBER OF APPLICATIONS PENDING 15

YEARS OR LONGER:

Jan. 15, 1914.....	84
Jan. 1, 1924.....	36

NUMBER OF APPLICATIONS PENDING 10

YEARS OR LONGER:

Jan. 1, 1912.....	289
Jan. 1, 1924.....	85

NUMBER OF APPLICATIONS PENDING 8

YEARS OR LONGER:

June 1, 1914.....	799
Jan. 1, 1924.....	192

NUMBER OF APPLICATIONS PENDING 5

YEARS OR LONGER:

Jan. 1, 1912.....	4296
Jan. 1, 1924.....	1599

All of the 36 applications now pending longer than 15 years are involved in interferences. The average time between the date of filing applications and the date of grant of patents is at present about 29 months. This is longer than usual because the Patent Office has fallen behind in its work owing to lack of sufficient force.

As there were pending in the Patent Office on January 1, 1924, 225,000 cases, only 1599, or .007 ~~per cent.~~ of these, had been pending longer than five years and only 192, or .0008 ~~per cent.~~ had been pending longer than eight years.

In 1916 the average time of pendency of applications in the Office was 21 months. Under fairly

normal conditions, the average time may be taken as about 2 years. This average includes the whole period of prosecution and all time after allowance, and there has been taken into the calculation all cases, including those delayed by interference or otherwise. It will thus be seen that the two-year rule would have no applicability to the average case.

The Patent Office has for many years had a regulation under which when an application for patent is ready for allowance, an examination is made of all other pending applications in the same class to see whether any of the claims of the allowable application could be made in any of the said other applications. If it is found that any of those claims could be made in any one of the other applications, the latter applicant is notified of the fact that the claims are being made by another party and informed that, if he wishes to copy them, he must do so within thirty days, under penalty of being held to have abandoned them. This practice effectually prevents delay in making the claims, where the Examiner seasonably discovers that an applicant is entitled to make the claims. The only reasons why it does not in all instances prevent delay in copying the claims are that there are not enough Examiners to thoroughly perform their work and that there will always be some error in every line of human endeavor.

As the Court may know, a very serious effort has been made by the patent bar and the scientific, technical, and industrial organizations of the country to raise the Patent Office from the desperate condition into which it had gradually fallen, partly through failure on the part of the legislature and the public to realize its importance and its needs, and more largely through the war, to

an efficient condition. That movement has succeeded in placing the salaries of the Patent Office where they draw and hold competent patent examiners, and movements within and without the administration and the Congress are now on the way to provide the Patent Office with an adequate number of examiners so that this work can be done with the minimum possible percentage of error, so that the possibility of patents being issued without notice to applicants who are entitled to make them, of claims therein, will be slight.

The American patent bar as a whole is also desirous of reducing the time of pendency of applications in the Patent Office by simplifying and shortening the procedure. For that purpose, the Patent Section of the American Bar Association has appointed a Committee on Patent Law Revision which has tentatively adopted a report proposing amendment to the Statute for reducing the number of appeals, both in interference and *ex parte* cases, and that report has been submitted to the various patent law associations throughout the United States, both national and local, for discussion and suggestion or approval.

Not only, therefore, has the Patent Office itself reduced to very small proportions the evil of delaying applications for patent in the Patent Office, but its present practice, when it has sufficient examiners to adequately carry it out, will usually prevent cases arising under the rule being considered in the case at bar.

The number of instances which, when the Patent Office has sufficient examiners, will exist in which the Patent Office inadvertently issues the patent without notifying the applicant who could have made the claims, and in which applications are

filed after the patent has been issued, and the applicant is not notified promptly of the existence of the patent will be so small as, in the opinion of the Amicus Curiae, to render it very unwise to adopt a remedy which would in any manner be unjust to innocent applicants, and thus decrease the incentive of inventors to invent.

The suggested analogy between delay in copying claims from a patent for purposes of interference and an application to broaden claims by reissuing the patent, which analogy caused the Court of Appeals of the District of Columbia, as stated in *DeFerranti v. Harmatta* (supra), to fix a uniform period of two years, after which an applicant might not make such a claim, is so far from being an exact one as to be inequitable to apply in such cases as the case at bar.

The need for reissue of a patent for the purpose of broadening a claim, being usually ascertainable by the patentee from an inspection of the patent itself, he may well be required generally to make the application for that purpose within two years; and yet, even here, the Court has held that that is not an invariable rule, saying in *Mahn v. Harwood*, 112 U. S., 354-363:

“As we have already stated, no invariable rule can be laid down as to what is reasonable time within which the patentee should seek for the correction of a claim which he considers too narrow. In *Miller v. The Brass Company*, by analogy to the law of public use before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and

we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case."

On the other hand, the adoption of a fixed period, after which an applicant may not copy the claim of a patent for purposes of interference, must in effect imply the actual knowledge by the applicant of all patents being granted within the field to which his invention relates during the pendency of his application, or of any divisional application filed not more than two years after his application matures in a patent. Except in the case of large corporations, it is, as a practical matter, usually impossible for an inventor to have such information. The Patent Office issues on an average 750 patents per week. While the drawings of the average patent comprise a number of figures and often very many full sheets of drawings, and while such patents, almost without exception, contain more than one and often very many claims, the Patent Office is unable to publish more than a single figure of each patent and a single claim. It would therefore be impossible for the inventor or his attorney, in most circumstances, to learn from the Official Gazette of the Patent Office whether claims were being patented to others which he should copy.

Except for the Patent Office and a few libraries in the United States, complete sets of all copies of patents are not accessible. Therefore, while the need for reissuing a patent for the purpose of broadening a claim is usually ascertainable from a mere inspection of the patentee's own patent, the knowledge that claims had appeared in an issued patent which an applicant could make is not accessible to most applicants; and for him

to employ an attorney to go to the Patent Office and inspect the 750 patents which are issued each week would involve an expense which is possible only to large corporations.

The Supreme Court, in its decision in *Chapman v. Wintroath* (*supra*), commented on the uncertainty of notice presumed to be derived from the publication of a patent, as compared with actual notice received from the Patent Office, saying:

(At pp. 138-9) "The one-year provision of Rev. Stats., §4898, as amended March 3, 1897, c. 391, 29 Stat. 693, is that an applicant for a patent, who shall fail to prosecute his application within one year after Patent Office action thereon 'of which notice shall have been given' him, shall be regarded as having abandoned his application, unless the Commissioner of Patents shall be satisfied that such delay was unavoidable. But when a conflict between inventions disclosed in applications escapes the attention of the Patent Office Examiners, Rev. Stats., §4909, and a patent is issued, with claims conflicting with the disclosures of a pending application, the applicant receives only such notice of the conflict as he is presumed to derive from the publication of the patent. In the one case the notice is actual and specific, in the other it is indefinite and constructive only. When the great number of patents constantly being issued is considered, many of them of a voluminous and complicated character, such as we have in this case, with many and variously worded claims, such an implied notice must necessarily be precarious and indefinite to a degree which may well have been thought to be a sufficient justification for allowing the longer two-year period to inventors who must, at their peril, derive from such notice their knowledge of any conflict with their applications."

The situation as to filing applications for re-issue of a patent for the purpose of broadening claims is therefore not analogous to the situation being considered in connection with the case at bar, and to follow that rule would be to work great hardship on all innocent inventors and their assignees, and the unjust consequences would fall most heavily on the individual inventor or patent owner, as distinguished from the large corporation.

The *Amicus Curiae* believes the foregoing considerations to clearly show that the rule should not set a fixed time within which all applicants must copy the claims of a patent, but that it should be one requiring that he insert the said claims in his application within a reasonable time under all the circumstances of the case.

The rule suggested would enable the courts to hold that claims had been abandoned, or that the party was estopped to make the claims whenever he had knowingly delayed to make them and wilfully procrastinated, whether the delay was less than two years or was longer than that period, and would enable the court to do strict justice in all cases.

To choose the rule of a fixed period of two years, or any other fixed period, would be in effect to imply that every claim in a patent which literally or in substance, might be found in an earlier patent, and which was not made in the application of the second patent within two years after the earlier patent was granted, was invalid in the second patent. This possibility would substantially decrease the salability of patents and would correspondingly discourage the production of inventions.

The road of the inventor from the time he files his application for patent to the obtaining of a decree sustaining his patent and finding infringement, even where it is clear that the defendant has obviously built upon his foundation, is so beset with obstacles that many who see the opportunity for valuable improvements and are capable of making them refrain from doing so, because of the danger of these unforeseen, and in many instances, unforeseeable defenses which are open to an ingenious, industrious and persistent defendant. The same dangers decrease the value of patents in the eyes of manufacturers or other possible purchasers. To add to such dangers the fact that, unless a patentee discover, within two years, that some claim—and perhaps the most essential claim—to which he is entitled had been made in a patent issued to another, and had not been copied by him within that period, or any other fixed period, would, in the long run, not only deprive many inventors of adequate protection for their inventions, but lay them under tribute, or at least subject them to suit for infringement of the said claim for practising their own invention. This experience would not only embitter the inventor, and I think justly so, but also those who had put money into or bought his rights.

There is a strong tendency on the part of a considerable portion of the public to look upon inventions always as an accomplished fact, and to look upon any curtailment of the inventors' monopoly as so much clear gain to the public, and the courts sometimes tend toward the same point of view. This is perhaps but natural, because such questions only arise in connection with inventions that have already been made, and

knowledge of which is in possession of the public. The real interest of the public and the object of the patent system lie, however, in the inducement to the inventor to go out into the unknown and create or bring into the realm of public knowledge inventions of which the public not only had no knowledge, but which it might never know but for the inducement of the patent system. The future progress of our country depends upon preserving that inducement strong enough so that inventors will invent, and so that they or their backers will risk the sums, often very large, which are usually required to bring an invention to a really useful embodiment.

The inventions produced under the stimulus of the American Patent System have had more to do with the prosperity of our country through the upbuilding of our industries and the multiplying of the hands of the farmer than any other factor. As a single tangible instance, it may be stated that but a small fraction of the vast areas of land which are under cultivation in the United States would be tilled today if it were not for the labor-saving machinery and other inventions with which the American inventor has provided the American farmer. The *Amicus Curiae* asked the Secretary of Agriculture for data on the effect that labor-saving machinery has had on the farmers' ability to produce crops, and his reply of February 8, 1924, is filed with this brief and printed as a supplement at p. 28. From the data therein given, it appears that according to the average practice in the areas where the most machinery is used, the hand method of producing crops would require four times the man-power that is required by the use of machinery. Even in the areas of the country where the most ma-

chinery is used, there is still much labor performed by hand on many farms for which machinery could be used to advantage, and if it were fully used, the number of men required in that area would undoubtedly be less than one-tenth of the number that would be required if the American inventor had not produced that machinery.

The Amicus Curiae telegraphed to the Campbell Farming Corporation of Hardin, Montana, stating that he wished to show how the American inventor has enabled the American farmer to displace hand labor with machinery and requesting them to telegraph him the number of acres in their immense farm and the approximate number of men employed upon it. The Corporation replied:

"APPROXIMATELY SEVENTY FIVE THOUSAND ACRES IN OUR FARM FOR THIS YEAR AND WE EMPLOY APPROXIMATELY THREE HUNDRED MEN IN SUMMER EXCLUSIVE OF MANAGERS AND FOREMEN."

Here then is a wheat farm of approximately 120 square miles which, through the inventions produced by the American Patent System, is cultivated by a force of only three hundred men, or one man to every 250 acres. Copies of the telegrams are printed at pages 32 and 33 of this brief.

centive. The maintenance of our industrial and agricultural supremacy and the security of our future require the full preservation of the incentive to invent. The inducement to produce inventions is now so far from satisfactory that the Amicus Curiae believes it would be dangerous to

knowledge of which is in possession of the public. The real interest of the public and the object of the patent system lie, however, in the inducement to the inventor to go out into the unknown and create or bring into the realm of public knowledge inventions of which the public not only had no knowledge, but which it might never know but for the inducement of the patent system. The fu

therein given, it appears that according to the average practice in the areas where the most machinery is used, the hand method of producing crops would require four times the man-power that is required by the use of machinery. Even in the areas of the country where the most ma-

chinery is used, there is still much labor performed by hand on many farms for which machinery could be used to advantage, and if it were fully used, the number of men required in that area would undoubtedly be less than one-tenth of the number that would be required if the American inventor had not produced that machinery. This machinery has almost wholly been invented by American inventors.

There are available in the United States, even in peace times, but a small fraction of the number of men that would be required if this cultivation were compelled to be conducted by the methods in use before the American Patent System. During the Great War, when millions of our men were withdrawn from agriculture and industry for military purposes, the United States could not have adequately fed itself and Europe would have starved, if it had not been for these same inventions. If necessity is the mother of invention, much more is the American Patent System the father of it. Necessity has always existed, but inventions did not begin to appear in substantial numbers until the creation of the American Patent System.

These inventions have been the direct result of the incentive of the short monopoly held out by our patent system. For we are not naturally more inventive than other peoples. We are Europeans by descent. Our greater inventiveness is a gradual development under the influence of that incentive. The maintenance of our industrial and agricultural supremacy and the security of our future require the full preservation of the incentive to invent. The inducement to produce inventions is now so far from satisfactory that the Amicus Curiae believes it would be dangerous to

further weaken it. The public would lose vastly more in the decreased production of inventions than could possibly be gained by any shortening or weakening of the monopoly.

The two-year rule is open to a further objection that it runs counter to a fundamental and long-established policy. The Patent Office and the courts have recognized a distinction between abandonment of an invention and abandonment of an application. In the effort to secure to an inventor his right to a patent, an act or omission which caused abandonment of an application has not been extended to effect abandonment of the invention unless some positive provision of the statute requires it. As the Court of Appeals of the 7th Circuit, speaking by Chief Justice Fuller in *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. Rep. 186, said (p. 191):

“There is a material difference between the abandonment of an invention and the abandonment of an application for letters patent thereon by failure to comply with section 4894 of the Revised Statutes. The first gives the invention to the public, and, once done, the act is irretrievable; but, besides the power conferred upon the Commissioner of Patents to relieve an applicant from an abandonment of his application under the statute, an application, which has lapsed, or been rejected or withdrawn, may be renewed or repeated so long, we suppose, as the invention itself has not been abandoned by reason of a two-years public use or otherwise.”

See also

*Hayes-Young Tie Plate Co. v. St. Louis
Transit Co.*, 137 Fed. Rep. 82,

in which many authorities are cited.

The two-year rule would reverse this policy and would effect an abandonment of the invention although the application had been properly filed and kept alive by diligent prosecution.

The Amicus Curiae therefore very respectfully, but most earnestly, urges the rejection of any rule for a fixed period within which an applicant may copy claims from a patent for purposes of interference, and urges the adoption of a rule requiring that he must do so only within a reasonable time under all the circumstances of the particular case.

Very respectfully,

EDWIN J. PRINDLE,
as Amicus Curiae.

New York City, Feb. 15th, 1924.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

WASHINGTON, D. C.

February 5, 1924.

E. J. PRINDLE, Esq.,
111 Broadway,
New York City.

My dear Mr. Prindle:

I am in receipt of your telegram asking me to give you figures as to delayed cases at the time Commissioner Ewing started his campaign to reduce the number of old cases on hand. Accordingly I am enclosing a copy of Commissioner Ewing's report for the calendar year 1914—see page 8. From this you will see that on January 15, 1914, there were 84 cases pending longer than 15 years (whereas there are now only 36); that on January 1, 1912, there were 289 applications pending longer than 10 years (whereas there are now 85); that on June 1, 1914, there were 799 cases pending longer than 8 years (whereas there are now only 192); and that on January 1, 1912, there were 4296 cases pending longer than 5 years (whereas there are now only 1599). I have purposely picked out the high spots in former years as a basis of comparison but you can ascertain the others from the report above referred to.

One interesting fact has developed regarding those cases *now* pending more than 15 years. While there are 36, they are all pending in one division—the division having charge of automatic telephones.

Each one of these 36 automatic telephone applications has been involved in and delayed by interference proceedings. Outside of these cases in this one division, there is not one application in the office which has been pending more than 15 years.

It is estimated that there are now on hand about 225,000 pending applications of which 63,535 are awaiting official action.

Yours very truly,

(Sgd.) THOMAS E. ROBERTSON,
Commissioner.

Seal of
United States
Department
of
Agriculture

DEPARTMENT OF AGRICULTURE

WASHINGTON

February 8, 1924.

MR. EDWIN J. PRINDLE,
111 Broadway,
New York, N. Y.

Dear Mr. Prindle:

Your letter dated January 30, in which you ask for data on the effect that labor-saving machinery has had on the American farmers' ability to produce crops, has been received.

The amount of machinery in use per farm worker or per farm varies greatly in different parts of the United States. However, the following table shows in a general way the effect that the use of farm machinery has had on the man labor required, per crop-acre, for a number of crops:

Hours of Labor Required per
Acre of Crops by various Methods

Crop	<i>Manual</i> Bank Method	Present Average Practice for U. S.	Average Practice in areas where most ma- chinery is used
	Hours	Hours	Hours
Barley	63.5	12.3	5.0
Corn—Cut up	182.7	52.6	
Corn—Husked in field....	38.7	18.9	14.5
Cotton	167.8	105.0	56.0
Timothy Hay	35.5	8.1	7.5
Oats	66.3	13.4	5.6
Rice	62.1	39.3	35.0
Rye	63.0	17.1	10.2
Wheat	61.1	10.0	5.8

I am enclosing two charts which show graphically the effect that the use of machinery has upon crop production.

Very truly yours,

(Sgd.) HOWARD M. GORE,
Acting Secretary.

Enclosures

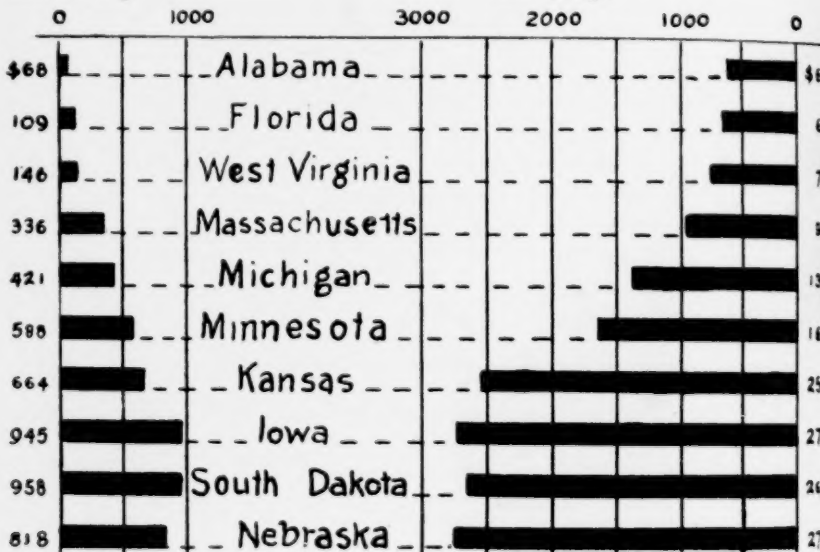
U. S. DEPT. OF AGRICULTURE

BUREAU OF PUBLIC ROADS

Relation Between
 INVESTMENT IN FARM MACHINERY
 and
 VALUE OF ALL CROPS
 PER PERSON ENGAGED IN AGRICULTURE
 1920 Census 1921 Year book, U. S. D. A.

Machinery

All Crops



U. S. DEPT. OF AGRICULTURE

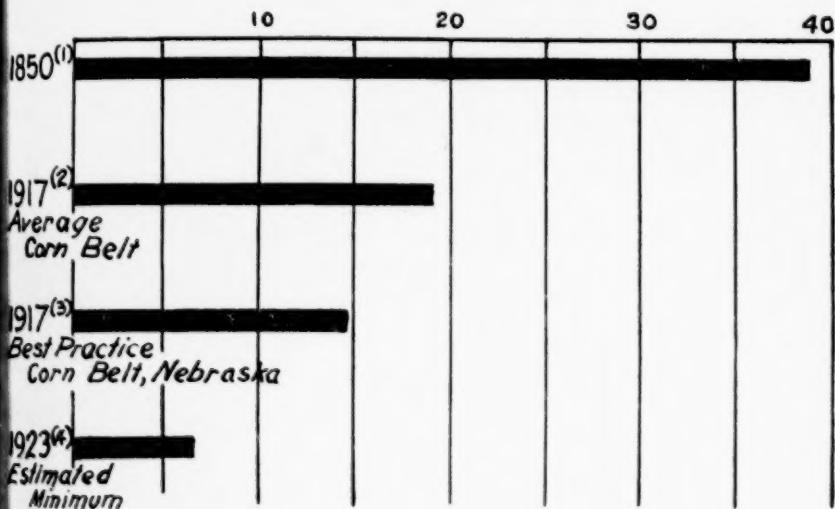
BUREAU OF PUBLIC ROADS

LABOR REQUIRED PER ACRE

for

PRODUCTION OF CORN

Number of Hours



(1) Thirteenth Annual Report, U. S. Department of Labor.

(2) 1921 Year book U. S. Dept. of Agriculture, page 191.

(3) 1921 Year book U. S. Dept. of Agriculture, page 191.

(4) Estimate based on the use of most modern equipment.

POSTAL TELEGRAPH COMPANY

February 21, 1924.

Campbell Farming Corporation,
Hardin, Montana.

Am conducting campaign to secure for Patent Office men, facilities and money necessary to enable it to work efficiently, and wish to show how American inventor has enabled American farmer to displace hand labor with machinery. Will Mr. Thomas Campbell or one of his staff please telegraph me, one eleven Broadway, New York, collect, number of acres in your immense farm and approximate number of men employed upon it.

Edwin J. Prindle.

WESTERN UNION TELEGRAPH COMPANY

February 26, 1924.

Hardin Mont.

Edwin J. Prindle

111 Broadway, New York, N. Y.

APPROXIMATELY SEVENTY FIVE THOUSAND
ACRES IN OUR FARM FOR THIS YEAR AND WE
EMPLOY APPROXIMATELY THREE HUNDRED
MEN IN SUMMER EXCLUSIVE OF MANAGERS
AND FOREMEN.

CAMPBELL FARMING CORPN.